-- REMARKS --

Claims 1-16 remain under consideration. Applicants thank Examiner Bonshock and Examiner Bayerl for their courtesies in the telephonic interview of May 24, 2004, but regret that the interview was not successful in reaching agreement.

A. The Examiner rejected claims 1-16 as anticipated by "MSWord"

The rejection of claims 1-16 as anticipated under 35 U.S.C §102(a) over MSWord is traversed. In order to maintain this §102(a) rejection, each and every element of the claimed invention must be disclosed in as great detail by the reference. Because the reference does not disclose each and every element, this rejection must fall.

As an initial matter, Applicants traverse the rejection on the grounds that MSWord is not prior art, per MPEP §2128 Since MSWord does not qualify as prior art, it cannot be used to support a rejection, and the rejection must be withdrawn.

First, the Examiner has not stated, nor even alleged, that documents were ever publicly accessible, much less accessible to persons concerned with the art to which the documents relate. While the source of the MSWord document is far from clear, the documents appear to be screenshots of the Examiner's own computer (see, MS Figure 8 which apparently includes the Examiner's 'name' "Dbonshock"), taken April 22, 2004 (see, bottom of "MS Figure 9"). Thus, the earliest these documents could possibly have been publicly accessible is 2.5 years after the filing of this application.

The MPEP is quite clear that a reference is a "printed publication" as required by §102(a) only "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that person interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." See MPEP 2128, In re Wyer, 655 F.2d 221 (CCPA 1981). The Examiner does not even allege that a single other person, much less, one of ordinary skill in the art, has access to his personal computer at the PTO.

The Examiner's inclusion of "MS Figure 8" appears targeted to show that the program was available prior to October 18, 2001. However, the copyright dates of a computer program are irrelevant to its status as a printed publication. Further, the screenshot illustrating the copyright dates does not show the allegedly anticipatory method in action, and therefore calls the anticipatory nature of the alleged reference into question.

While the Examiner may argue that he need not prove anyone actually looked at the document, he must show both that someone could have (i.e. see MPEP 2128.01) and the date that the publication is available as a reference. The Examiner has failed on both counts here. First, the Examiner has not alleged that his computer was available to the public prior to October 18, 2001. Second, the Examiner has not alleged any dates that the publications were available to the public.

Thus, for at least the ground that the Examiner's "reference" is not prior art, Applicants request withdrawal of the rejections to claims 1-16.

However, a §102(a) rejection further requires that the reference disclose each and every element of the claimed invention in at least as great detail as claimed. As the "reference" does not disclose "displaying the graphical image associated with the icon in response to the icon preview instruction," as claimed in claims 1 and 9, the §102(a) rejection cannot support a prima facie case of anticipation.

At most, the "reference" discloses that a *text* sample of the clipboard icon is disclosed upon a mouse action, and not the display of a *graphical* image. See, MS Figure 2. Those of ordinary skill in the art readily recognize the differences between text and graphics. Indeed, an example of the difference is apparent from an inspection of MS Figure 2. Those of ordinary skill in the art are well acquainted with ASCII characters and fonts – ASCII characters serve to allow a computer to recognize characters of different fonts as the same character. Thus, for example "The cat ran up the hill" is rendered in Times New Roman font (in MS Figure 2), but the computer recognizes the ASCII characters in that text string as being capable of rendering in multiple fonts. "The cat ran up the hill" *could* also be rendered in Arial font - "The cat ran up the hill", Bookman Old Style - "The cat ran up the hill" or a multitude of other well-recognized fonts. In MS Figure 2, the allegedly anticipatory illustration illustrates the text string in different fonts, making apparent to one of ordinary skill in the art that the computer is using a text string, rather than a graphical image. Were the Examiner's computer using a graphical image, the fonts on the two samples, (i.e. on the screen and on the popup) would be identical. Because the fonts are different (the onscreen version uses a serif font, while the pop-up version is rendered in a sans-serif font), those of ordinary skill in the art will recognize that the computer is using ASCII characters rather than graphical images.

Additionally, MS Figure 9 not only does not disclose the claimed elements, MS Figure 9 unequivocally teaches away from displaying a graphical image – "If the item is a drawing object or picture, or an item that doesn't contain text, Microsoft Word displays a label "Picture 2," which indicates the order in which the item was copied." Such a statement clearly indicates not only that the "reference" does not teach displaying "the graphical image associated with the icon," but the statement directly teaches away from doing such an action. Furthermore, MS Figure 9 teaches and discloses that the program can only preview "50 characters of text."

Applicants further note that the "reference" does not teach or suggest the desirability of using a graphical icon as a preview. In addition, none of the other cited references disclose the claimed invention.

Because the "reference" and other cited references do not disclose each and every element of claims 1 and 9, Applicants request the withdrawal of the §102(a) rejections of these claims, and claims 2-3 and 10-11 depending therefrom.

CONCLUSION

The Applicants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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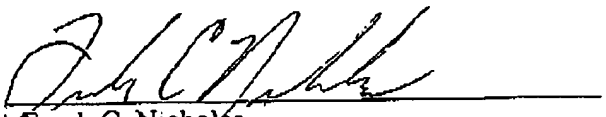

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